

REMARKS

Applicants express appreciation for the acknowledgement that the requirement for election of a SEQ ID NO as a separate invention has been reviewed and reconsidered.

Applicants first address the objections to the specification and the rejections under 35 U.S.C. §112 ¶2.

The specification has been amended to delete two hyperlinks in the paragraph beginning at page 8 line 30 and one hyperlink in the paragraph beginning at page 9, line 17. No hyperlinks were found at 8:15, 8:19, and 9:10. Clarification is requested.

The rejection of claim 38 based on the inclusion of two sentences in the claim is moot, as claim 38 has been cancelled.

Claim 33 has been amended to delete the word "substantially". The metes and bounds of the claim are now clear. Claim 39 has been cancelled.

Claims 34 has been amended to specify the stringency of hybridization. The metes and bounds of the claim are now clear. Claim 40 has been cancelled.

The rejection of claim 38 based on failure to further limit base claim 32 and based on the absence of the deposit accession number (CRL-1729) and is moot in view of the cancellation of claims 32 and 38.

Claim 35 has been amended to specify that the "portion" of the specified sequence is a continuous segment of the specified SEQ ID NO. Claim 41 has been cancelled.

Applicants now address each of the points presented at pp. 5-8 of the office action.

I. Prior Art

Applicants are entitled to their claim of priority based on USSN 60/209,093, filed June 2, 2000.

Claims 32 and 38 are rejected based on §102(b) based on the disclosure of p62 (a c-myc gene product said to bind antibody 9E10) in Ambros (*Materia Medica Poloa* (1992) vol. 24, pp. 76-78). Claims 32 and 38 have been cancelled and that rejection is moot.

Claim 32 is rejected based on §102(b) based on the disclosure of CD10 Chu et al. (*Am J. Clinic. Pathol.* (March, 2000) vol. 113, pp. 374-382. Claim 32 is cancelled and that rejection is moot.

Claims 32, 33, 34, 35, 39, 40 and 41 are rejected based on §102(e) based on the disclosure of SEQ ID NO:931 in Rosen et al. PCT WO 01/55322. This rejection is traversed. Rosen et al. is a published PCT application of approximately 935 pages with over 900 sequence listings in it. Rosen et al. claim priority to no fewer than 138 provisional applications filed between 31 January 2000 and 5 January 2001. Only eight of those 138 provisional applications pre-date Applicants priority filing on June 2, 2000. The office action does not allege that the sequence listing at issue (NO:931) is contained in any of those eight provisional filings.

MPEP 2136.03 Section IV provides for a brief description of case law concerning 102(e) CIP rejections. In order to carry back the 35 U.S.C 102(e) critical date to the filing date of a parent application, the parent application must contain the subject matter at issue. The MPEP references *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981). The principles are clear. Disclosure added after Applicants' invention may never be relied on as prior art. Specifically, the court stated, "an abandoned application by itself can never be a reference." Id. at 535. To support this rejection the Examiner must indicate at least one pre-June 2, 2002 filing containing SEQ ID NO:931.

Moreover, while §102(e) permits rejections based on published PCT applications that are in English and that are themselves filed before the Applicants' priority date, it is not apparent that such a rejection may be based on the priority date asserted in that PCT filing, even assuming one or more of Rosen et al.'s pre-June 2, 2002 provisional applications does contain SEQ ID NO:931.

Claims 19, 32-35 and 39-41 are rejected under §102(b) based on the disclosure of the jjAZ1 sequence (accession number Q15022) disclosed in Nagase et al. (DNA Research (1995) vol. 2, pp. 167-174). The office action concludes that the Q15022 is 100% identical to SEQ ID NO:5. Claims 19, 32 and 39-41 have been cancelled and this rejection is moot.

Applicant : Jason Koontz et al.
Serial No. : 09/874,162
Filed : June 4, 2001
Page : 11 of 11

Attorney's Docket No.: 05311-024001

As amended, claim 33 features SEQ ID NO:8, and there is no indication that Nagase et al. discloses SEQ ID NO:8. The basis for rejecting claim 34 based on Nagase is not clear. There any indication that Nagase et al. discloses a continuous sequence that amounts to 80% of SEQ ID NO:8, as specified in claim 35. (Basis for the amendment to claim 35 is at page 18, line 25 of the specification.

In view of the amendments to claims 33-35, the rejections based on 35 U.S.C. §112 ¶1 are overcome.

Enclosed is a \$475 check for the Petition for a Three-Month Extension of Time fee.
Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: May 10, 2004

John W. Freeman
John W. Freeman, Esq.
Reg. No. 29,066

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906